

REMARKS

In the Office Action mailed September 19, 2007, Claims 1, 4-13, 27, and 30-48 were pending in the present application. By the present amendment, Claims 1 and 27 have been amended, and Claim 8 has been canceled. In the Office Action, the Examiner rejected all pending Claims under 35 U.S.C. § 103(a) as allegedly obvious over Goers et al. (U.S. Patent 6,722,952) in view of Homola (US 20040096705). It should be noted that the Office Action is inconsistently marked as “Final” and “Non-final” (Non-final in Office Action Summary, Final in conclusion of the body of the Office Action). Clarification was sought from Examiner Rachuba via voice message. Examiner Rachuba kindly replied in a voice message left for Applicant on October 10, 2007, that the status of the Office Action is Non-final. Such status of the Office Action is relied on by the following response.

By the present amendment, the subject matter of Claim 8, particularly the nanodiamond particles including a carbonaceous coating, has been included in each of Claims 1 and 27. Consequently, Claim 8 has been canceled. Such amendment to Claims 1 and 27 is supported by originally filed Claim 8, as well as page 13, lines 23-29 of the specification as originally filed. Accordingly, Applicant respectfully submits that no new matter is added by this amendment. Such amendments are made without conceding the correctness of the present rejections and without prejudice to Applicant’s right to pursue canceled or removed subject matter in a future application. Applicant believes that pending Claims 1, 4-7, 9-13, 27, and 30-48 present allowable subject matter, and reconsideration and allowance thereof is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

The standards for establishing a *prima facie* case of obviousness were presented in a previous response. With this in mind, Applicant contends that the cited references fail to make a *prima facie* case of obviousness in that the cited reference combinations fail to teach or suggest all of the claim limitations of Applicant's invention.

Claims 1, 4-13, 27, and 30-48 were rejected as allegedly obvious over Goers et al. in view of Homola. Applicant respectfully submits that the amended claims are patentable over the cited references for lack of teaching of each and every element, and requests that the rejections be withdrawn.

Independent Claims 1 and 27 have been amended to recite the nanodiamond particles include a carbonaceous coating. As taught in the specification, such carbonaceous coatings can provide a soft skin with lubricating properties, and a superhard interior suitable for polishing a surface, thus allowing for removal of material from a workpiece without scratching or damaging the workpiece. See page 13, lines 23-28.

The Examiner admits in paragraph 5 of the Office Action that Goers does not disclose nanodiamond particles including a carbonaceous coating. The Examiner then states, "In a similar apparatus, '705 [Homola] teaches that it is known to use nanodiamonds in a polishing pad. The nanodiamonds include a carbonaceous coating ..." See paragraph 5. Respectfully, the Applicant can not find a teaching of a carbonaceous coating in Homola. The Examiner fails to provide any guidance as to what grounds the Examiner relies on to state that point, and does not cite to the text of Homola.

Upon close reading of Homola, Applicant believes the Examiner may have erroneously relied on a statement found in paragraph [0026], stating "...the diamond particles comprise about 90% or more of diamond, with some ash and/or oxidatable carbon marking up the remainder." It is clear from reading the quoted text, however, that such statement is directed to the composition of the diamond particle and does not reference or infer coating such diamond particles. At best, the statement defines the possible composition of diamond particles usable in the Homola invention. Such interpretation is consistent with the heading [0025] entitled "Description of Types of Nano-Diamond Particles Used with the Invention." As such, Homola, even with the assumed citation, fails to teach nanodiamond particles including a carbonaceous coating.

As, by the Examiner's admission, Goers et al. fails to teach nanodiamond particles including a carbonaceous coating, and Homola fails to teach the same, a *prima facie* case of obviousness cannot be sustained and the rejection should be withdrawn.

CONCLUSION

In view of the foregoing, Applicant believes that presently pending Claims 1, 4-7, 9-13, 27, and 30-48 present allowable subject matter and allowance is respectfully requested. If any impediment to the entry of this Amendment and allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone Mr. David Osborne at (801) 566-6633, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 20-0100.

Dated this 16th day of January, 2008.

Respectfully submitted,

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